

REMARKS

Background

This Amendment is being filed in response to the Office Action dated November 21, 2002. Claims 1-38 were originally filed with the application on October 28, 1999. By way of a preliminary amendment filed on November 16, 2000, claims 1-11, 13-16, 20, 21, 24-32 and 34-38 were amended and claims 39-84 were added. In a Supplemental Preliminary Amendment and Response to Restriction Requirement filed on April 19, 2002, claims 54, 62, 65 and 66 were amended and claims 85 and 86 were added. In addition, claims 1-52 and 69-76 were cancelled without prejudice. In an Amendment filed on August 22, 2002 in response to an office action, claims 53 and 77 were amended.

Claims 53, 61, 77 and 84 are currently amended by the present Amendment. Accordingly, claims 53-68 and 77-86 are presently in the application. Claims 53, 61, 77 and 84 are independent.

Rejection Under 35 USC § 102(e)

In the Office Action, claims 61-63 and 66 were rejected under 35 U.S.C. §102(e) based on U.S. patent no. 6,282,548 to Burner et al.

Burner is directed to a method of generating and displaying metadata concurrently with a Web page. The purpose of the invention described by Burner is to present information that "augments" the information on a Web page being displayed on a display device by a browser. The method includes receiving information identifying the Web page that is being displayed, sending, to a metadata server, a request for metadata related to the Web page being displayed and displaying that information. See Burner at col. 3 lines 7-17. In Burner, a button bar 405 is

displayed docked apart from a browser window or floating. See Burner at Fig. 4 and at col. 8, lines 56-64. With further reference to Fig. 4 of Burner, button bar 405 is separate and distinct from the Web browser and its browser interface. Indeed, Burner discloses the client interfacing with the browser without the appearance of the browser being altered. See Burner at col. 2, lines 45-47.

Applicant's invention, in contrast, and as recited by claim 61, as amended, for example, is directed to an Internet browser interface displayable by an Internet browser having at least one Internet browser toolbar having predetermined functionality. The Internet browser interface, after being enabled via a connection to a predetermined Internet site, includes a user toolbar having additional functionality in addition to the predetermined functionality of the Internet browser toolbar. Importantly, after being enabled via a connection to a predetermined Internet site, a user toolbar having additional functionality (in addition to the predetermined functionality that is displayed as part of the original Internet browser interface) is displayed as part of the Internet browser interface. The user toolbar is displayed along with and in addition to the Internet browser toolbar while the Internet browser is activated. See, e.g., user toolbar 42 of FIG. 4 of the present application. Additionally, the user toolbar of the invention of claim 61 is displayed regardless of which Internet site the computer is connected to via the Internet browser.

Applicant respectfully submits that Burner does not disclose all of the features of claim 61, as amended, of the present application. For example, claim 61, as amended, of the present application recites a toolbar displayed as part of the Internet browser. In stark contrast, Burner discloses a toolbar that is separate and distinct from the browser. Accordingly, the toolbar of

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Burner bears a significant disadvantage, and indeed teaches away from the invention of claim 61, as amended, of the present application.

Dependent claims 62, 63 and 66, depend either directly or indirectly from claim 61. Accordingly, claims 62, 63 and 66 are distinguishable from Burner, at least for the reasons stated above with respect to the rejection of claim 61.

Applicant thus respectfully submits that the invention recited by claims 61-63 and 66, is patentably distinguishable over Burner. Applicant further respectfully submits that the invention recited by claims 61-63 and 66 is not anticipated by Burner, as that reference fails to teach or suggest each element recited by those claims, as is required of a proper 35 U.S.C. § 102(e) reference. See, e.g., MPEP § 706.02. Accordingly, applicant respectfully requests withdrawal of the rejection of claims 61-63 and 66 as anticipated by Burner. Applicant further respectfully submits that the invention recited by claims 61-63 and 66 is not rendered obvious by any proposed hypothetical combination of Burner and any other prior art of record or with the knowledge of a person of ordinary skill in the art. Early notification of allowance is requested.

Rejections Under 35 USC § 103(a)

In the Office Action, claims 53, 54, 56, 57, 77-79, 81, 82, 84 and 85 were rejected under 35 U.S.C. §103(a) based on a hypothetical combination of Burner and an Alexa Internet information Web page (“Alexa”).

Applicant respectfully traverses that rejection. In the first instance, there is no teaching or suggestion in the references to make the hypothetical combination proposed in the Office Action, and thus the combination is improper.

Independent claims 53, 77 and 84, as amended, of the present application recite similar limitations to those discussed above with respect to independent claim 61. Specifically, claim 53 is directed to a method of controlling an Internet browser interface displayable by an Internet browser on a display of a computer. The method comprises, *inter alia*, the steps of providing, at a predetermined Internet site, access to a program for controlling the Internet browser interface and making available for downloading by the predetermined Internet site, a file for causing the display of a user toolbar that makes additional functionality that is not part of the Internet browser prior to download, available to the user after download. Similarly to claim 61, discussed above, after download of the claimed file, the user toolbar is part of the Internet browser interface.

Similarly, claim 77 recites an added user toolbar as part of the browser interface and offering user toolbar functionality in addition to that provided by the Internet browser prior to a file being downloaded, and claim 84 recites a toolbar that is part of the browser interface, the user toolbar and the functions not being available to the user via the browser interface prior to a claimed file being downloaded.

Accordingly, for reasons stated above with respect to the rejection of claim 61, applicant respectfully submits that Burner does not disclose all of the features of independent claims 53, 77 and 84, as amended, of the present application. Specifically, because Burner is directed to a toolbar that is separate and distinct from a browser window, Burner does not disclose a toolbar that is part of the browser interface, as is recited by claims 53, 77 and 84, as amended, of the present application.

Furthermore, Alexa fails to cure that deficiency. Alexa describes an "Alexa Toolbar" which may be installed at the bottom of a user's screen. See Alexa at Download Instructions Step 3. Accordingly, Alexa discloses a toolbar at the bottom of the user's screen and not as part of the Internet browser interface.

Applicant thus respectfully submits that the invention recited by independent claims 53, 77 and 84 is patentable over the proposed hypothetical combination of Burner and Alexa, and respectfully requests withdrawal of the rejection of those claims.

Dependent claims 54, 56, 57, 78, 79, 81, 82 and 85 depend either directly or indirectly from one of claims 53 and 77. Accordingly, applicant submits that claims 54, 56, 57, 78, 79, 81, 82 and 85 are patentable over the proposed hypothetical combination of Burner and Alexa, at least for the reasons stated above with respect to claims 53 and 77.

Moreover, with respect to the rejection of claim 85, while applicant acknowledges that the Examiner has officially noticed that it is known to have an Internet browser automatically display a "home page" in a browser window upon initialization of the browser, applicant submits that claim 85 of the present application is not directed to such automatic display of a home page. Accordingly, applicant respectfully submits that the invention recited by claims 54, 56, 57, 78, 79, 81, 82 and 85 is patentable over the proposed hypothetical combination of Burner and Alexa, and respectfully requests withdrawal of the rejection of those claims.

In the Office Action, claims 55 and 58 were rejected under 35 U.S.C. §103(a) based on a hypothetical combination of Burner and Alexa and U.S. Patent No. 6,292,185 to Ko et al. ("Ko").

Applicant respectfully traverses that rejection. In the first instance, there is no teaching or suggestion in the references to make the hypothetical combination proposed in the Office Action, and thus the combination is improper.

Dependent claims 55 and 58 depend either directly or indirectly from claim 53. Accordingly, applicant submits that any proposed hypothetical combination of Burner and Alexa fails to disclose all of the features of claims 55 and 58, at least for the same reasons discussed above with respect to the rejection of claim 53, from which claims 55 and 58 depend.

Furthermore, Ko fails to cure those deficiencies. Ko only discloses "a method and apparatus for tailoring a graphical user interface," where the graphical interface may include a Web browser. See, e.g., Ko at column 1, lines 21-22 and lines 57-58. In accordance with the teachings of Ko, an entirely new, customized Web browser is provided that "accesses functional programs of the user's minimized Web browser." See, e.g., Ko at column 7, lines 9-13. Thus, the "original browser" interface must be minimized and replaced by a completely new customized browser interface. Applicant respectfully submits that that is clearly not the invention recited by claims 55 and 58. As claims 55 and 58 depend either directly or indirectly from claim 61, the distinguishing remarks set forth above with regard to that claim and a hypothetical Burner-Alexa combination also apply to the Examiner's rejection of claims 55 and 58. Furthermore, because Ko discloses a minimized browser window being replaced by a new interface, Ko cannot and does not disclose a user toolbar being part of the Internet browser interface. In addition, Ko does not suggest or provide motivation for a user toolbar being part of the Internet browser interface. Indeed, because Ko discloses minimizing the original browser window, and creating an entirely new interface separate and apart from the original browser

interface, Ko teaches away from a user toolbar being part of the original browser interface. Applicant thus respectfully submits that claims 55 and 58 are not rendered obvious by the proposed hypothetical combination of Burner and Alexa and Ko, and applicant respectfully requests withdrawal of the rejection of those claims.

Claims 58 and 83 were rejected under 35 U.S.C. §103(a) in view of a hypothetical combination of Burner and Alexa and "Using Microsoft Internet Explorer 4" ("MS IE").

Applicant respectfully traverses that rejection. In the first instance, there is no teaching or suggestion in the references to make the hypothetical combination proposed in the Office Action, and thus the combination is improper.

Dependent claims 58 and 83 depend indirectly from claims 53 and 77 respectively. Accordingly, applicant submits that any proposed hypothetical combination of Burner and Alexa fails to disclose all of the features of claims 58 and 83, at least for the same reasons discussed above with respect to the rejection of claims 53 and 77, from which claims 58 and 83 depend.

Furthermore, MS IE fails to cure those deficiencies. MS IE describes a search window that may be viewed alongside a Web page viewing window. See MS IE at page 42. The search window that may be viewed is provided by software as an integral part of the Web browser software as delivered by the Web browser provider. As such, the search window described in MS IE describes a toolbar provided as part of the original browser, in this case, by Microsoft. Accordingly, MS IE does not disclose a file for causing the display of a user toolbar that makes additional functionality that is not part of the Internet browser prior to download, available to the user after download, as is recited by claim 53, as amended, of the present application. Claim 77

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similarly recites that after download of the file, the user toolbar is part of the Internet browser interface.

Accordingly, while MS IE does disclose the availability of a search window within a browser interface, the functionality of the search window disclosed by MS IE is part of the original Internet browser interface, and accordingly only provides functionality that is part of the Internet browser prior to download of a file from a predetermined Internet site.

Accordingly, MS IE does not cure the deficiencies of the proposed hypothetical Burner-Alexa combination, as MS IE does not disclose a user toolbar that provides functionality that is not part of the Internet browser prior to download of a file from a predetermined Internet site, with the toolbar being part of the browser interface subsequent to the download.

Thus applicant respectfully submits that the invention recited by claims 58 and 83 is not rendered obvious by the proposed hypothetical combination of Burner, Alexa and MS IE. Applicant thus respectfully submits that the invention recited by claims 58 and 83 is patentable over the proposed hypothetical combination of Burner, Alexa and MS IE, and respectfully requests that the rejection of those claims be withdrawn.

Claims 59 and 60 were rejected under 35 U.S.C. §103(a) based on a hypothetical combination of Burner and Alexa and U.S. patent No. 6,020,884 to MacNaughton et al. (“MacNaughton”).

Applicant respectfully traverses that rejection. First, there is no teaching or suggestion in the references to make the hypothetical combination proposed in the Office Action, and thus the combination is improper.

In addition, dependent claims 59 and 60 depend, either directly or indirectly, from claim 53. Accordingly, applicant submits that any proposed hypothetical combination of Burner and Alexa fails to disclose all of the features of claims 59 and 60, at least for the same reasons discussed above with respect to the rejection of claim 53, from which claims 59 and 60 depend.

Furthermore, MacNaughton fails to cure those deficiencies. MacNaughton discloses a system and method for integrating an on-line service community with a foreign service such as the Internet. See, e.g., MacNaughton Abstract. MacNaughton further teaches a toolbar 196 comprised of control buttons and a viewer, and that operates as an extension of the user's browser. A "Toolbar and Capabilities Manager 68 is responsible for creating and managing the Community "Toolbar" that appears on the user's screen." See, e.g., MacNaughton at column 10, lines 55-58. MacNaughton discloses that the "toolbar and Capabilities Manager 68 interacts with the Capability Handler(s) so that the toolbar controls for various capabilities are made available to the user." See, e.g., MacNaughton at column 10, lines 63-66. However, that disclosure does not overcome the shortcomings of Burner and Alexa, as set forth in detail above. For example, MacNaughton does not disclose a user toolbar that provides functionality that is not part of the Internet browser prior to download of a file from a predetermined Web site, with the toolbar being part of the browser interface subsequent to the download of the file. Thus, applicant respectfully submits that the invention recited by claims 59 and 60 is not rendered obvious by the proposed hypothetical combination of Burner, Alexa and MacNaughton. Applicant thus respectfully submits that the invention recited by claims 59 and 60 is patentable over the proposed hypothetical combination of Burner, Alexa and MacNaughton, and respectfully requests withdrawal of the rejection of those claims.

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In the Office Action, claim 64 was rejected under 35 U.S.C. §103(a) based on a hypothetical combination of Burner, Alexa and MS IE.

Applicant respectfully traverses that rejection. First, there is no teaching or suggestion in the references to make the hypothetical combination proposed in the Office Action, and thus the combination is improper.

In addition, dependent claim 64 depends indirectly from claim 61. Accordingly, applicant submits that Burner fails to disclose all of the features of claim 64, at least for the same reasons discussed above with respect to the rejection of claim 61, from which claim 64 depends.

Furthermore, as discussed above with respect to the other rejections based upon proposed hypothetical combinations including Alex and MS IE, neither of those references disclose, for example, a user toolbar, enabled after download of a file from a predetermined Internet site, having additional functionality in addition to the predetermined functionality of the Internet browser toolbar.

Thus, applicant respectfully submits that the invention recited by claim 64 is not rendered obvious by the proposed hypothetical combination of Burner, Alexa and MS IE. Applicant thus respectfully submits that the invention recited by claim 64 is patentable over the proposed hypothetical combination of Burner, Alexa and MS IE, and respectfully requests withdrawal of the rejection of that claim.

In the Office Action, claim 65 was rejected under 35 U.S.C. §103(a) based on a proposed hypothetical combination of Burner and Ko.

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Applicant respectfully traverses that rejection. First, there is no teaching or suggestion in the references to make the hypothetical combination proposed in the Office Action, and thus the combination is improper.

In addition, dependent claim 65 depends indirectly from claim 61. Accordingly, applicant submits that Burner fails to disclose all of the features of claim 65, at least for the same reasons discussed above with respect to the rejection of claim 61, from which claim 65 depends.

Furthermore, as discussed above with respect to the rejections based upon Ko, Ko fails to cure the deficiencies of Burner. For example, a user toolbar, enabled after download of a file from a predetermined Internet site, having additional functionality in addition to the predetermined functionality of the Internet browser toolbar is not disclosed by either Burner or Ko.

Thus, applicant respectfully submits that the invention recited by claim 65 is not rendered obvious by the proposed hypothetical combination of Burner and Ko. Applicant thus respectfully submits that the invention recited by claim 65 is patentable over the proposed hypothetical combination of Burner and Ko, and respectfully requests withdrawal of the rejection of that claim.

In the Office Action, claim 67 was rejected under 35 U.S.C. §103(a) based on a hypothetical combination of Burner and McNaughton.

Applicant respectfully traverses that rejection. First, there is no teaching or suggestion in the references to make the hypothetical combination proposed in the Office Action, and thus the combination is improper.

In addition, dependent claim 67 depends indirectly from claim 61. Accordingly, applicant submits that Burner fails to disclose all of the features of claim 67, at least for the same reasons discussed above with respect to the rejection of claim 61, from which claim 67 depends.

Furthermore, as discussed above with respect to the rejections based upon MacNaughton, that reference fails to cure the deficiencies of Burner. For example, neither Burner nor MacNaughton disclose a user toolbar being part of the Internet browser interface, enabled after download of a file from a predetermined Internet site, having additional functionality in addition to the predetermined functionality of the Internet browser toolbar.

Moreover, while applicant acknowledges that the Examiner has officially noticed that it is known to have an Internet browser automatically display a "home page" in a browser window upon initialization of the browser, applicant submits that claim 67 of the present application is not directed to such automatic display of a home page.

Thus, applicant respectfully submits that the invention recited by claim 67 is not rendered obvious by the proposed hypothetical combination of Burner and MacNaughton. Applicant thus respectfully submits that the invention recited by claim 67 is patentable over the proposed hypothetical combination of Burner and MacNaughton, and respectfully requests withdrawal of the rejection of that claim.

In the Office Action, claim 68 was rejected under 35 U.S.C. §103(a) based on a hypothetical combination of Burner, MacNaughton and U.S. Patent No. 6,119,098 to Guyot et al. ("Guyot").

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Applicant respectfully traverses that rejection. In the first instance, there is no teaching or suggestion in the references to make the hypothetical combination, and thus the combination is improper.

In addition to the arguments set forth above with respect to Burner and the rejection of claim 61, from which claim 68 indirectly depends, and the arguments set forth above with respect to MacNaughton, Guyot only discloses a system and method for targeting and distributing advertisements over the Internet. In Guyot, a client application displays downloaded advertisements in an advertising window that is continuously displayed on a subscriber's computer, even if other applications are running at the same time. See, e.g., Guyot at column 2, lines 2-6. Guyot does not disclose, for example, a user toolbar being part of the Internet browser interface, enabled after download of a file from a predetermined Internet site, having additional functionality in addition to the predetermined functionality of the Internet browser toolbar. Further, the shortcomings of Burner and MacNaughton, as set forth in detail above, and in no way overcome by the disclosure of Guyot. Thus, applicant respectfully submits that the invention recited by claim 68 is not rendered obvious by the Examiner's proposed combination of Burner, MacNaughton and Guyot, and applicant respectfully requests withdrawal of that rejection.

In the Office Action, claim 86 was rejected under 35 U.S.C. §103(a) based on a hypothetical combination of Burner, Alexa and Guyot.

Applicant respectfully traverses that rejection. First, there is no teaching or suggestion in the references to make the hypothetical combination proposed in the Office Action, and thus the combination is improper.

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In addition, dependent claim 86 depends, indirectly, from claim 53. Accordingly, applicant submits that any proposed hypothetical combination of Burner and Alexa fails to disclose all of the features of claim 86, at least for the same reasons discussed above with respect to the rejection of claim 53, from which claim 86 depends.

Furthermore, for reasons stated above with respect to the other rejections based upon Guyot, that reference fails to cure those deficiencies.

Thus, applicant respectfully submits that the invention recited by claim 86 is not rendered obvious by the proposed hypothetical combination of Burner, Alexa and Guyot. Applicant thus respectfully submits that the invention recited by claim 86 is patentable over the proposed hypothetical combination of Burner and Alexa and Guyot, and respectfully requests withdrawal of the rejection of that claim.

Hindsight

With regard to the various hypothetical combinations of references cited in the Office Action, applicant notes that no motivation to combine these references is presented in the Office Action.

As discussed above, applicant respectfully traverses the cited combinations of references on grounds that these combinations involve impermissible hindsight reconstruction of the invention involving "picking and choosing" from the teachings of that art. "Care must be taken to avoid hindsight reconstruction by using the application "as a guide through the maze of prior art references combining the right references in the right way so as to achieve the result of the claims in suit." Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907 (Fed. Cir. 1988).

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Conclusion

Applicants have considered the prior art of record, and respectfully submit that none of the references relied upon by the Examiner in rejecting the claims of the present application, considered alone or in any hypothetical combination (between and among each other or with the knowledge of a person of ordinary skill in the art), teach or suggest applicant's invention, as recited by the claims of the present application.

Applicant respectfully requests reconsideration of the present application in view of the amendments to the claims and in view of the remarks provided herein.

Early and favorable consideration of the present application in view of the amendments to the claims and remarks provided herein is respectfully requested. If the Examiner is not in a position to allow all claims as presently amended, the Examiner is urged to call the undersigned attorney at 212-806-5400. Any additional fees or charges required at this time or in the future in connection with the present application are hereby authorized to be charged to Deposit Account No.

19-4709.

Respectfully submitted,

By _____

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